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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,190	11/04/2003	Edward R. diGirolamo	4782-042	5075

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EXAMINER
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DREIDAME, HUNTER M

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/701,190

Applicant(s)

DIGIROLAMO ET AL.

Examiner

Hunter M. Dreidame

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/04/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

Claims 1 – 25 are pending and have been examined in this office action.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 – 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 21 of copending Application No. 10/682,586 in view of US Patent 4,677,802 to Vukmanic. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are to the same structure although using different terminology.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show first projection 100 in figure 2A – 2B as described in the specification on page 16, line 15. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, line 1 refers to the 'stud spacer of claim 5.' It is not clear as to whether the claim should be dependent upon claim 1 or claim 4. For purposes of examination, it is assumed claim 5 is dependent upon claim 4. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 16 – 18 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 10/682,586 which has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e)

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is based upon a presumption of future publication or patenting of the copending application.

Claim 1:

A stud spacer for extending between two studs comprising a main member adapted to extend between the two studs (claim 21, line 2), the main member including first and second end portions (claim 21, line 3), a projection extending from each end portion (claim 21, lines 4 and 5); wherein the projections of the main member interlock with similar projections of other main members (claim 21, lines 6 – 9).

Claim 16:

A wall structure, comprising a series of spaced apart studs with each stud having an opening formed therein (claim 12, lines 2 and 3), a series of stud spacers extending between respective studs (claim 12, lines 7 and 8); each stud spacer including first and second projections that extend from opposite ends of the stud spacer (claim 12, lines 12 – 14), said first and second projections of each stud spacer adapted to connect to first and second projections of other stud spacers so as to interconnect the stud spacers of the wall structure (claim 12, lines 12 – 14), and each projections including a locking surface (claim 14, line 1) and a locking stop (claim 13, lines 1 and 2) and wherein when interconnected the locking surface of the first projection is engaged with the locking stop of the second projection and the locking surface of the second projection is engaged with the locking stop of the first projection (claims 14 and 15).

Claim 17:

The wall structure of claim 16 wherein when connected the respective projections at least partially overlie one another (claims 14 and 15).

Claim 18:

The wall structure of claim 17 wherein the first projection includes a terminal end portion and an opening (claims 13 – 15) and the second projection includes a terminal end and an opening (claims 13 – 15) and wherein the terminal end portions of the respective projections are projected through the openings within the projections when the projections are interconnected (claims 13 – 15).

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 – 15, and 19 - 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application 10/682,586 of Torres and diGirolamo in view of US Patent 4,677,802 to Vukmanic.

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Claim 2:

Torres and diGirolamo disclose the stud spacer of claim 1. Torres and diGirolamo do not disclose a locking surface, an opening, a deflector disposed adjacent the opening, and a stop. Vukmanic teaches a fastener element comprising a locking surface (column 4, line 52; figure 2, character 54), an opening (column 4, line 39; figure 2, character 50), a deflector disposed adjacent the opening (column 4, line 42; figure 2, character 51), and a stop (column 4, line 46; figure 2, character 53). In view of Vukmanic, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have combined the stud spacer of Torres and diGirolamo with the fastening element of Vukmanic, because it would provide a strong, easy connection between two stud spacers.

Claim 3:

The stud spacer of claim 2 wherein when two projections are interlocked, the locking surface of one projection engages the stop of the other projection (Vukmanic, column 6, lines 11 – 30).

Claim 4:

The stud spacer of claim 1 wherein each projection is elongated (Vukmanic, figure 2) and when connected to a similar projection at least partially overlies or underlies the similar projection (Vukmanic figures 3 and 5).

Claim 5:



The stud spacer of claim 4 wherein each of the two projections includes a deflectable terminal end (Vukmanic, column 4, lines 39 – 40; figure 2, character 50) and an opening (Vukmanic, column 4, lines 39 – 40; figure 2, character 50).

Claim 6:

The stud spacer of claim 1 wherein each projection includes a terminal end portion (Vukmanic, column 4, lines 39 – 40; figure 2, character 50), a locking tab disposed on the terminal end portion (column 4, line 52; figure 2, character 54), a deflector disposed inwardly of the locking tab (Vukmanic, column 4, lines 39 – 40; figure 2, character 50); an opening formed in the projection adjacent the deflector (Vukmanic, column 4, lines 39 – 40; figure 2, character 50), and a stop disposed inwardly of the opening (Vukmanic, column 4, line 46; figure 2, character 53).

Claim 7:

A stud spacer assembly for extending between a series of studs, comprising at least first and second stud spacers (Torres and diGirolamo, figure 1), said first stud spacer including a first projection and said second stud spacer including a second projection (Torres and diGirolamo, figure 6), said first and second projections adapted to interlock so as to connect the first and second stud spacers together (Torres and diGirolamo, figures 7A – 7D) , and wherein each projection includes a locking surface (Torres and diGirolamo, figures 7A – 7D) and a stop and wherein when interlocked (Vukmanic, column 4, line 46; figure 2, character 53), the locking surface of the first projection is engaged with the stop of the second projection and the locking surface of

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the second projection is engaged with the stop of the first projection (Vukmanic, figures 3 – 5).

Claim 8:

The stud spacer assembly of claim 7 wherein when connected the first and second projections overlie each other (Vukmanic figures 3 and 5).

Claim 9:

The stud spacer assembly of claim 8 wherein each projection includes an opening (Vukmanic column 4, line 39; figure 2, character 50) and wherein when connected the first projection extends through the opening of the second projection and the second projection extends through the opening of the first projection (Vukmanic, column 5, lines 2 – 11; figures 3 and 5).

Claim 10:

The stud spacer assembly of claim 9 wherein at least a portion of each projection is at least slightly yieldable such that a portion of each projection can slightly flex during the course of interconnecting the projections (Vukmanic figure 4).

Claim 11:

The stud spacer assembly of claim 7 wherein each projection includes an opening (Vukmanic, column 4, lines 39 – 40; figure 2, character 50) and a deflector (Vukmanic, column 4, lines 39 – 40; figure 2, character 50) and wherein the locking surface of each projection is formed on a terminal end portion of the projection (Vukmanic, column 4, lines 39 – 40; figure 2, character 50) and wherein when connected the terminal end portion of the first projection projects through the opening in

the second projection (Vukmanic, figures 3 – 5) and the terminal end portion of the second projection projects through the opening in the first projection (Vukmanic, figures 3 – 5).

Claim 12:

The stud spacer assembly of claim 11 wherein the deflector of the first projection deflects the terminal end of the second projection through the opening of the first projection (Vukmanic, figures 3 –5) and wherein the deflector of the second projection deflects the terminal end of the first projection through the opening in the second projection (Vukmanic, figures 3 –5).

Claim 13:

The stud spacer assembly of claim 7 wherein the locking surface includes a tab (Vukmanic, column 4, line 52; figure 2, character 54) and the stop includes a tab receiving opening (Vukmanic, column 4, lines 39 – 40; figure 2, character 50) and wherein when the first and second projections are interconnected the first projection is extended over a portion of the second projection and a portion of the first projection is inserted through the opening in the second projection such that the locking tab of the first projection seats within the tab receiving opening formed in the second projection (Vukmanic, figures 3 –5) and wherein the second projection is extended underneath a portion of the first projection and a portion of the second projection is inserted through the opening in the first projection wherein the locking tab of the second projection seats within the tab receiving opening of the first projection (Vukmanic, figures 3 –5).

Claim 14:

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The stud spacer of assembly of claim 13 wherein each projection includes a deflector disposed adjacent the tab receiving opening (Vukmanic, column 4, lines 39 – 40; figure 2, character 50) and wherein the deflector on the first projection deflects a portion of the second projection upwardly through the opening in the first projection (Vukmanic, figures 3 –5), and wherein the deflector in the second projection deflects a portion of the first projection downwardly through the opening in the second projection (Vukmanic, figures 3 –5).

Claim 15:

The stud spacer assembly of claim 7 wherein the locking surface of each projection includes a tab (Vukmanic, column 4, line 52; figure 2, character 54) and wherein the stop of each projection includes a tab receiving opening (Vukmanic, column 4, lines 39 – 40; figure 2, character 50) and when the projections are connected the respective tabs are seated within the tab receiving openings (Vukmanic, column 4, lines 39 – 40; figure 2, character 50).

Claims 19 – 25:

Torres and diGirolamo disclose the stud spacer given above when combined with the connecting means of Vukmanic. Torres and diGirolamo do not disclose a method for connecting the stud spacers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the method of connecting the stud spacers as described in claims 19 – 25 because that is the only possible way to connect the stud spacers.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter M. Dreidame whose telephone number is (571)272-5177. The examiner can normally be reached on Monday - Friday 10am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on (571)272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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